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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/710,690

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Chris Carmichael

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PO Box 1389
Rancho Santa Fe, CA 92067

EXAMINER

GLASS, RUSSELL S

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/710,690	Applicant(s) CARMICHAEL ET AL.	
	Examiner R. SHAY GLASS	Art Unit 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 27, 29, 30 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
2. As per claims 27 and 36, it is noted that Applicant's specification defines branding, not rebranding as used in the claim, (see Specification, p. 13, lines 2-8). Rebranding as used in the claims occurs at the physical order fulfillment location and is representative of the server of a web-based business. Branding as defined in Applicant's specification comprises using packaging previously marked with the insignia of the indirect seller. It is unclear how rebranding can occur via materials that have already been branded by the indirect seller.
3. As per claims 29 and 30, it is noted that Applicant's specification discloses analyzing shipping and sales information to determine product trends based on either geographic territory or demographics, (see Specification, p. 18, lines 13-15). However, the Applicant claims analyzing orders. Orders are not the same as shipping and sales, as an order typically precedes the shipping/sales event.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 27 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, it is unclear whether the server in the claims can be and/or must always be the indirect seller described in the specification. A server is a machine, and an indirect seller is an entity performing steps in a business method. A server need not be specifically tied to one entity or another, but rather is well-known to perform functions for a host of users, one of whom may or may not be an indirect seller.

5. **Claims 21-23 and 25-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Rothman et al. (2002/0072984).**

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. As per claims 21 and 34, Rothman et al. teaches a method, comprising:

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receiving an order over the Internet at a server, via a web- based interface, said order received from a consumer, said order specifying at least one product to be purchased (see Rothman, abstract)(disclosing purchasing products over the Internet);

receiving payment information from said consumer over the Internet (see Rothman, ¶ 39)(disclosing a third party payment server);

based on said receiving said order and said payment, determining one of a plurality of different order fulfillment locations to send said at least one product to said consumer, (see Rothman, abstract)(disclosing that based on information supplied by the buyer a local retailer is selected to ship the purchased product);

sending contents from said order, from said one of said order fulfillment locations based on said determining, to the consumer, using a shipping method (see Rothman, abstract)(disclosing that based on information supplied by the buyer, selecting a local retailer to ship the purchased product);

subsequent to said sending, allowing the consumer to return the contents from said order to a local retailer, different than said server and different from said one of said order fulfillment locations, (see Rothman, ¶ 47), and

responsive to said consumer returning said contents, refunding the payment received as part of said payment information, (see Rothman, ¶ 47)(disclosing returning a product ordered online to a local retailer and receiving a refund for the return).

7. As per claim 22, Rothman et al. teaches maintaining an inventory management system that determines for said plurality of fulfillment locations, amounts of inventory maintained at least at a plurality of said fulfillment locations, (see Rothman, abstract)(disclosing local retailers

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providing inventory information to the online commerce store).

8. As per claim 23, Rothman et al. teaches wherein said determining comprises determining an order fulfillment location to send said product which is physically closest to said consumer, (see Rothman, ¶ 75)(disclosing order fulfillment by a local retailer based on address information).

9. As per claim 25, Rothman et al. teaches storing information indicative of inventory at local retailers, and also storing information indicative of other local retailers, and using said information to select one of said retailers to send said products, and using said refund of said item to increase an indication of a number of items stored at said retailer, (see Rothman, ¶ 47)(disclosing a local retailer keeping the returned product for resale).

10. As per claims 26 and 35, Rothman et al. teaches order fulfillment locations have different names than a name associated with said server which receives said order, and wherein said order fulfillment location receives said name associated with said server, (see Rothman, abstract)(disclosing a branded product sold through a local retailer having a branded name associated the online store/online product).

11. As per claims 27 and 36, Rothman et al. teaches rebranding the order at the order fulfillment location using said name associated with said server, (see Rothman, fig. 13)(disclosing a "hearts on fire diamond" sold online and shipped from a local retailer).

12. As per claim 28, Rothman et al. teaches informing the order fulfillment location when the consumer returns a product, (see Rothman, ¶ 47)(The customer informs the fulfillment location of a return by presenting the return to the fulfillment location).

13. As per claim 29, Rothman et al. teaches analyzing orders to determine product trends

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based on geographic territory, (see Rothman, ¶ 45)(disclosing that sales are tracked for commission and compensation purposes for each distributor or employee of a distributor).

14. As per claim 30, Rothman et al. teaches analyzing orders to determine product trends based on demographics (see Rothman, ¶ 45)(disclosing that sales are tracked for commission and compensation purposes for each distributor or employee of a distributor).

15. As per claim 31, Rothman et al. teaches a method, comprising:

receiving an order over the Internet at a server, via a web- based interface, said order received from a consumer, said order specifying at least one product to be purchased (see Rothman, Abstract)(disclosing purchasing products over the Internet);

receiving payment information from said consumer over the Internet (see Rothman, ¶ 39)(disclosing a third party payment server);

based on said receiving said order and said payment, determining one of a plurality of different order fulfillment locations to send said at least one product to said consumer, wherein said order fulfillment locations have different names than a name associated with said server which receives said order, and wherein said order fulfillment location receives said name associated with said server (see Rothman, abstract)(disclosing that based on information supplied by the buyer a local retailer is selected to ship the purchased product);

rebranding the order at the order fulfillment location using said name associated with said server (see Rothman, fig. 13)(disclosing a "hearts on fire diamond" sold online and shipped from a local retailer);

sending contents from said order to the consumer, from said one of said order fulfillment locations based on said determining, and including said rebranding, using a shipping method,

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said sending being to said consumer (see Rothman, abstract)(disclosing information supplied by the buyer wherefrom a local retailer is selected to ship the purchased product).

16. As per claim 32, Rothman et al. teaches subsequent to said sending, allowing the consumer to return the contents from said order to a local retailer different than said server and different from said one of said order fulfillment locations, and responsive to said consumer returning said contents, refunding the payment received as part of said payment information (see Rothman, ¶ 47)(disclosing returning a product ordered online to a local retailer and receiving a refund for the return).

17. As per claim 33, Rothman et al. teaches maintaining an inventory management system that determines for said plurality of fulfillment locations, amounts of inventory maintained at least at a plurality of said fulfillment locations (see Rothman, Abstract)(disclosing local retailers providing inventory information to the online commerce store).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. **Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rothman et al. (2002/0072984) in view of Borders et al. (2007/0174144).**

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20. As per claim 24, Rothman et al. discloses all elements of the claimed invention, but fails to explicitly disclose wherein said determining comprises determining an order fulfillment location to send said product which is within a specified mailing time to said consumer.

Borders et al. discloses online store product availability including: wherein said determining comprises determining an order fulfillment location to send said product which is within a specified mailing time to said consumer (see Borders, ¶ 41)(disclosing customers scheduling a specific date and time for delivery of a product through the online store).

From this disclosure of Borders et al. it would have been obvious to one having ordinary skill in the art at the time that the invention was made to modify the online store system of Rothman et al. to include allowing the customer to schedule an delivery date and time in order to facilitate delivery of customer orders when a customer is home (see Borders, ¶ 41).

Response to Arguments

Applicant's arguments filed 12/10/2009 have been fully considered but they are not persuasive for the following reasons.

1. In response to Applicant's argument that the Rothman reference was incorrectly applied under 35 U.S.C. 102(b), it is noted that in the last office action mailed 7/22/2008, the reference was applied correctly as a reference under 35 U.S.C. 102(e) as of its earliest effective filing date of 6/1/2000.

2. In response to Applicant's argument that the Rothman reference fails to disclose determining one of a plurality of different order fulfillment locations to send said at least one product to said consumer, and sending contents from said order, from said one of said order

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fulfillment locations based on said determining, it is submitted that in addition to the references already provided, that the Rothman reference further discloses a plurality of different order fulfillment locations from which an order is sent to a customer, (see Rothman, fig. 4).

3. In response to Applicant's argument that the Rothman reference fails to disclose sending from an order fulfillment location that is physically closest to the customer, it is submitted that in addition to the references already provided, that the Rothman reference further discloses that orders may be sent from a distributor within the geographic region of the customer, (see Rothman, ¶43).

4. Furthermore, it is submitted that in addition to the references already provided, that the Rothman reference further discloses rebranding the order at the order fulfillment location using said name associated with said server (see Rothman, figs. 16 and 17). Rothman discloses, e.g., placing an order for a "Hearts on Fire" diamond at the "Hearts on Fire" server-supported website, having the "Hearts on Fire" diamond etched with a unique "Hearts on Fire" registration number, and then shipping the "Hearts on Fire" diamond to a Christian Bernard jewelers, Hillside location for pickup by a Stephen Walker. If Christian Bernard jewelers were to provide the "Hearts on Fire" diamond to the customer in a Christian Bernard box, the customer can use the unique "Hearts on Fire" registration number to determine if he in fact received a "Hearts on Fire" diamond.

5. In response to Applicant's argument that Rothman fails to disclose product trends or demographics, it is submitted that the claims, when given their broadest reasonable interpretation in light of applicant's specification, read upon the cited portions of the prior art dealing with tracking sales data for commission and compensation, (see Rothman, ¶ 45).

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Conclusion

The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. SHAY GLASS whose telephone number is (571)272-7285. The examiner can normally be reached on weekdays between 9 AM and 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MATTHEW GART can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. SHAY GLASS/
Examiner, Art Unit 3687

/Vanel Frenel/
Examiner, Art Unit 3687
April 27, 2009

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